

Appl. No. : 09/991,721
Filed : November 13, 2001

REMARKS

Applicant wishes to thank Examiners Sullivan for the courtesy extended to Nancy Vensko, attorney of record, on September 13, 2004. The Interview Summary Form PTOL-413 summarizes the discussion held at the personal interview. The present response to the outstanding Office Action includes the substance of the Examiner Interview.

A. Disposition of Claims

By this amendment, Applicant has amended Claims 1 and 25. Claims 28-44 have been added. Thus, Claims 1-13, 15, 17, 18, 25, 27 and 28-44 are pending. This amendment is presented to make explicit that which was implicit in Claims 1 and 25, and thus for reasons unrelated to patentability. Support for the amendment is found throughout the specification, for example, as indicated in original claims 16 (environment of use) and 25 (product by process), paragraph 0069 (neoplastic cell), and paragraph 0016, 0022-0025, and 0027, and 0028 (VVGf phenotype) No new matter has been added. Reexamination and reconsideration of the application, as amended, are respectfully requested.

B. Compliance with Patentable Subject Matter Requirement

The Patent Office rejected Claims 1-13, 15, 17, 18, 25 and 27 under 35 U.S.C. §101 as being directed to nonstatutory subject matter, because the claims are given the broadest reasonable interpretation to encompass a human being. The claims have been amended such that one set is directed to a tumor cell that explicitly disclaims encompassing a mammal (e.g., a human being) and the other set is directed to a vaccinia virus. The set of claims directed to a tumor cell does not encompass a mammal because a mammal is explicitly disclaimed. The set of claims directed to a vaccinia virus is limited to its environment of use "present in vivo in a mammalian tumor cell," because the broadest reasonable interpretation of the claims is to limit the vaccinia virus to its environment of use. For these reasons, the claims define patentable subject matter.

C. Compliance with 35 USC 112, first paragraph

The Patent Office rejected Claims 1-6, 12, 13, 15, 17, 18 and 27 under 35 USC 112, first paragraph, as failing to comply with the written description and enablement requirements. The

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problem solved by the present invention is the lack of a vaccinia vector that is double deleted to divide preferentially in tumor cells as opposed to normal cells. The claims have been amended to conform to the solution provided by the double deletion vaccinia virus. The rejection is thus rendered moot.

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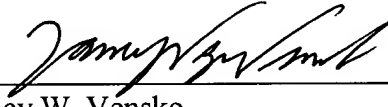
CONCLUSION

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of all outstanding rejections are respectfully requested. Allowance of the claims at an early date is solicited. If any points remain that can be resolved by telephone, the Examiner is invited to contact the undersigned at the below-given telephone number.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 9/20/04

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